

REMARKS

The applicant has carefully considered the Office action dated September 2, 2008, and the references it cites. Claims 31, 37-45, and 48-64 are pending in the current application, claims 43 and 55 have been withdrawn, and claims 32-36 and 46-47 have been cancelled without prejudice to their further prosecution. In view of the following remarks, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102

The Office action rejected claims 31, 37, and 44 under 35 U.S.C. § 102(e) as anticipated by Delgado et al. (U.S. Patent Publication No. 2005/0076570). The applicants respectfully request withdrawal of the § 102(e) rejections based on Delgado et al., because Delgado et al. (U.S. Patent Publication No. 2005/0076570), as relied on in the Office action, does not constitute prior art to the pending application under § 102(e).

Delgado et al. (U.S. Patent Publication No. 2005/0076570) was filed on August 19, 2004, whereas the pending application was filed on January 9, 2004. The relevant portion of 35 U.S.C. § 102(e) states that:

A person shall be entitled to a patent unless-

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent

Using the pending application's January 9, 2004 filing date as a constructive date of invention means that Delgado et al. (U.S. Patent Publication No. 2005/0076570) was not "filed in the United States before the invention by the applicant for patent," as is required under § 102(e).

The applicants do note that Delgado et al. (U.S. Patent Publication No. 2005/0076570) is a continuation-in-part of an application filed on December 16, 2002, which, in turn, claimed priority to a provisional application filed on December 14, 2001. Both of these dates pre-date the constructive invention date of the current application (filed January 9, 2004). However, in making its rejections, the Office action relies on new matter that was first disclosed in the continuation-in-part application (filed on August 19, 2004).

For example, in rejecting claims 31, 37 and 44, the Office action points to an alleged “lower track 22, 74 (see figures 15 and 16)” (Office action of September 2, 2008, page 4), and alleges that “the panel retention system remains in contact with the lower track 74 even if the door panel moves out of the predetermined normal path” (*id.* at 4). Similarly, in the “Response to Arguments” the Examiner alleges that, “as shown in figures 15 and 16 the track 22 includes a track portion 70 which engages the panel retention system when the door panel 14 is out of the predetermined path. Thus, Delgado et al. anticipates the limitations of claim 31” (*id.* at 8). Alleged lower track 74, track portion 70 and Figures 15 and 16 were not disclosed until the continuation-in-part was filed on August 19, 2004. Therefore, in making its § 102(e) rejections, the Office action relies on matter which has a priority date of August 19, 2004, which does not predate the constructive invention date of the current application (January 9, 2004).

The MPEP addresses the issue of continuations-in-part as they relate to § 102(e) as follows: “the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under 35 U.S.C. 102(e)” (MPEP § 2136.03-

IV). Here, the subject matter used in the rejection clearly was not disclosed in the earlier-filed application, and is not entitled to the earlier filing date. For at least this reason, the rejections of claims 31, 37, and 44 under § 102(e) as anticipated by Delgado et al. are improper, and the applicants respectfully request their withdrawal.

The Office action rejected claims 57-59 under 35 U.S.C. § 102(b) as anticipated by Delgado et al., again relying on matter not disclosed until the continuation-in-part was filed on August 19, 2004. Specifically, the Office action alleges that “the resilient connection allows the door panel to move out of the predetermined path when subjected to an impact force but applies a restorative force to the panel that has both a horizontal component and a vertical component to return the door panel to the predetermined normal path upon removal of the impact force by virtue of the interaction of the track portion 74 and the retention system 24” (Office action of September 2, 2008, page 5). As detailed above, Delgado et al., as applied in the Office action, is not a proper § 102(e) reference, much less a proper § 102(b) reference, as is asserted in connection with claims 57-59. For at least this reason, the rejections of claims 57-59 under § 102(b) as anticipated by Delgado et al. are improper, and the applicants respectfully request their withdrawal.

For at least the foregoing reasons, the applicants request the withdrawal of all standing § 102 rejections and the allowance of claims 31, 37, 39, and 57-59.

REJECTIONS UNDER 35 U.S.C. § 103

The Office action rejected claims 31, 37-42, 44, 45, 48-54, 56, and 60-64 under 35 U.S.C. § 103(a) as unpatentable over Delgado et al. in view of Linstadt (U.S. Patent No. 1,802,519). The Examiner’s reasons for the rejections, including references to the

reasons for previous claim rejections, and the individual recitations of the rejected pending claims, establishes that the § 103(a) rejections are based upon the subject matter not disclosed in Delgado et al. until the filing of the continuation-in-part patent application. As detailed above, Delgado et al., as relied on by the Office action is not proper prior art. Therefore, the applicants respectfully submit that the rejections of claims 31, 37-42, 44, 45, 48-54, 56, and 60-64 under 35 U.S.C. § 103(a) as unpatentable over Delgado et al. in view of Linstadt are improper and respectfully request their withdrawal.

CONCLUSION

Based on the foregoing remarks, it is respectfully submitted that all claims are in condition for allowance. If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

The Commissioner is hereby authorized to charge any deficiency in the amount enclosed or any additional fees which may be required under 37 CFR 1.16 or 1.17 to Deposit Account No. 50-2455.

Please refund any overpayment to Hanley, Flight & Zimmerman, LLC at the address below.

Respectfully submitted,

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